

**REMARKS**

This Amendment is responsive to the Office Action mailed on October 6, 2004. Claims 1, 7, 9, 14, 20, and 22 are amended. Claims 1-27 are pending.

The Examiner has indicated that claims 4, 9-11, 13, 17, 22-24, and 26 contain allowable subject matter.

Claims 1-3, 5, 6, 8, 12, 14-16, 18, 19, 21, and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by Katzin (US 6,261,253).

Claims 7 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Katzin in view of Grim (US 5,058,576).

Claim 27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Katzin

Applicant respectfully traverses these rejections in view of the amended claims and the following comments.

**Discussion of Amended Claims**

Independent claims 1 and 14 are amended to specify that the distal section extends at a fixed angle to the proximal section.

Claims 7 and 20 are amended to clarify that the outer shell is comprised of plastic which is malleable after heat-treating.

Claims 9 and 22, which contain allowable subject matter as indicated by the Examiner, are amended into independent form by including the original subject matter of claims 1 and 14, respectively. Applicant respectfully submits that claims 9 and 22 are therefore in condition for immediate allowance.

**Discussion of Katzin**

Claims 1-3, 5, 6, 8, 12, 14-16, 18-19, 21, and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Katzin. This rejection is respectfully traversed. An anticipation rejection

requires that each and every element of the claimed invention as set forth in the claim be provided in the cited reference. See *Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186 (CA FC 2003), and cases cited therein. As discussed in detail below, Katzin does not meet the requirements for an anticipation rejection.

Katzin discloses a deformable brace 10 which comprises an exterior cover 22 and a deformable inner 24 (Col. 3, lines 48-50). The deformable inner 24 is made up of a stiffener 28 which is laminated between two thin opposing sheets. The stiffener has two end plates 32 and 34 joined by a narrower mid portion 36. The end plates 32 and 34 and mid portion 36 may be part of a single plate 40 of uniform thickness with a reinforcing strip 42 fixed along the mid portion 36. The plate 40 and the reinforcing strip 42 are made of mild steel and the plate is such that it can be bent by moderate manual force (Col. 3, lines 55-66).

As can be seen from the foregoing, the design of Katzin is substantially more complicated compared to the simple design of Applicant's claimed brace, which comprises a one-piece outer shell and a soft inner shell, with straps attached to the outer shell.

Further, the brace of Katzin is made of mild steel that can be bent to conform the brace to the wearer and the specific injury. In particular, the inner 24 of Katzin is provided in an initially planar condition. This inner section can be bent in both the longitudinal and transverse directions to conform the brace to the contour of the limb (Col. 4, lines 37-41), as acknowledged by the Examiner (Office Action, page 2). Further, with Katzin, as therapy progresses, the curvature of the waist portion 18 of the brace 10 is gradually reduced (i.e., the brace 10 is bent back towards its original planar position) to achieve extension of the hand and wrist from the initially retracted position. Katzin indicates: "The materials of which stiffener 28 is constructed are chose so that the stiffener, and consequently the splint 10, can be formed to the desired shape by deliberate manual force applied by a therapist, but yet will resist forces to which it is normally subject when worn by a patient." (Col. 4, lines 57-64).

In contrast to Katzin, with Applicant's claimed brace, the distal section and the proximal section are arranged at a fixed angle with respect to one another. Since Applicant's claimed brace is formed at a fixed angle, it affords significantly more structural stability than the bendable brace

of Katzin. For example, after repeated bending from one position to another, the inner 24 of the brace 10 of Katzin, which is made of mild steel, will weaken and eventually break or snap at the point of bending. Further, with the brace of Katzin, there is a risk that the patient may (accidentally or purposefully) bend the brace 10 out of the position in which it is placed by the therapist. Such problems, which are inherent to the design of Katzin, are not present in the design of Applicant's claimed fixed angle brace.

Katzin does not disclose or remotely suggest a preformed metacarpal brace having a one piece semi-rigid molded outer shell having a distal section extending at a fixed angle to a proximal section, as claimed by Applicant. In fact, by providing a brace 10 that is bendable by manual force alone, Katzin teaches away from Applicant's claimed invention.

As Katzin does not disclose each and every element of the invention as claimed, the rejections under 35 U.S.C. § 102(b) are believed to be improper, and withdrawal of the rejections is respectfully requested. See, *Akamai Technologies Inc., supra*.

Applicant respectfully submits that the present invention is not anticipated by and would not have been obvious to one skilled in the art in view of Katzin, taken alone or in combination with Grim or any of the other prior art of record.

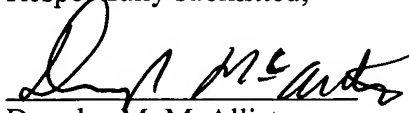
Further remarks regarding the asserted relationship between Applicant's claims and the prior art are not deemed necessary, in view of the foregoing discussion. Applicant's silence as to any of the Examiner's comments is not indicative of an acquiescence to the stated grounds of rejection.

Withdrawal of the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) is therefore respectfully requested.

Conclusion

The Examiner is respectfully requested to reconsider this application, allow each of the pending claims and to pass this application on to an early issue. If there are any remaining issues that need to be addressed in order to place this application into condition for allowance, the Examiner is requested to telephone Applicant's undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Doug McAllister', is written over a horizontal line.

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